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10/615,585	07/07/2003	Michiaki Otani	9333/352	8983

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EXAMINER

JACKSON, JAKIEDA R

ART UNIT	PAPER NUMBER
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2626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/615,585

Applicant(s)

OTANI, MICHIAKI

Examiner

Jakieda R. Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. In response to the Office Action mailed December 28, 2006, applicant submitted an amendment filed on February 27, 2007, in which the applicants amended and requested reconsideration with respect to independent **claims 1, 7, 11 and 16**.

Response to Arguments

2. Regarding independent claims 1, 7, 11 and 16, Applicant's argue that the amended claims now overcome the 112 rejection. However, it does not. For example, the claims recites "means for translating an original text item in the first language to be converted to voice"..... It was stated in the previous office action that the original text is not the text that is converted and voiced, according to the claim language. Instead it is the new text. The claim language claims "means for translating an original text item in the **first language to be converted into voice** into a new text item" by the steps recited. The limitation following states "means for generating voice by pronouncing the new text item according to the pronunciation of the second language". Again, the original text is never converted to voice. Nowhere in the claim does it complete the original text translation and voiced steps. For example, if the original text is the word "she". When, according to the limitation is the word "she" spoken, when the claim states that it is converted into voice? "She" is never spoken. If the second language was Spanish, the end result would be the word "ella" spoken, not "she".

Applicant further argues that Regenar does not provide an automated system or method for replacing a character or string in an original text in a first language that is not

included in a second, output language with a character or string in the second language that has an equivalent or similar pronunciation. In response to applicant's arguments, the recitation automated has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Besides, Regenar does teach an automated device (column 38, line 66 – column 39, line 5).

Applicant also argues that Regenar does not disclose an automated means or method of providing a voice output by pronouncing the new text item according to the pronunciation of the second language. To the contrary, Regenar teaches away from Applicant's automated invention by expressly distinguishing computer translators that do not provide fixed visual aids or user interaction (column 2, lines 11-19 and column 38, lines 50-65). However, arguments that alleged anticipatory prior art teaches away from the invention is not germane to a rejection under section 102. A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference teaches away from the invention is inapplicable to an anticipation analysis.

Applicant's further argue that Regenar does not disclose a navigation apparatus, a map database for storing geographic information containing a place name text item

representing each place name, or a means for reading out a place name text item from the map database. However, Regenar teaches a collection subsystem for obtaining information relative to navigating in rural and urban areas (column 13, lines 40-67). Therefore, Applicant's arguments are not persuasive.

Applicant's further argue that claim 7 recites that when the original text item is abbreviated, the replacement of a character or string is done according to the full original text item, however, Conkie describes a linguistic processor of a speech synthesizer that pronounces a **non-abbreviated** word in a same language as the abbreviation. However, Conkie teaches expanding conventional abbreviations and to translate **non-alphabetic** characters into a pronounceable form. For example, St. abbreviation should be pronounced Saint or Street (column 4, lines 31-57). Besides, Conkie was used to teach the translation of abbreviated text, while Regenar teaches the actual language translation. Therefore, Applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 7 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, applicant claims means for translating an original text, an abbreviated text, and the place name and a method for

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translating an original text, however, according to the claim, it is the new text item being translated and voiced, not the original text.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-6 and 11-16** are rejected under 35 U.S.C. 102(b) as being anticipated by Renegar (USPN 6,024,571).

Regarding **claims 1 and 11**, Renegar discloses an automated voice generator and method (computer system; column 38, line 66 – column 39, line 5), hereinafter referenced as a voice generator for generating a voice output in the pronunciation of a second language corresponding to a text item in a different first language, comprising:

means for translating an original text item in the first language to be converted into voice into a new text item by replacing a character or string included in the original text item and not included in a second language with the second language character or string having a pronunciation equivalent or similar to the pronunciation of the character or string in the first language (figure 2 with column 16, lines 40-67 and column 17, line 56 – column 18, line 35 with column 25, lines 6-30); and

means for generating voice by pronouncing the new text item according to the pronunciation of the second language (column 5, lines 64-67).

Regarding **claim 2**, Renegar discloses a voice generator according wherein the original text item comprises place name text items assigned to respective places (column 13, lines 52-67).

Regarding **claims 3 and 12**, Renegar discloses a voice generator wherein the first language character or string and the second language character or string are included in a place name text item representing a place name (column 13, lines 52-67 with column 16, lines 40-67 and column 17, line 56 – column 18, line 35 with column 25, lines 6-30).

Regarding **claims 4 and 13**, Renegar discloses a voice generator wherein the first language character or string is in French and the second language character or string is in English (column 39, lines 59-63).

Regarding **claims 5 and 14**, Renegar discloses a voice generator wherein the first language character or string is in Spanish and the second language character or string is in English (column 39, lines 59-63).

Regarding **claims 6 and 15**, Renegar discloses a voice generator wherein the first language character or string is in German and the second language character or string is in English (column 39, lines 59-63).

Regarding **claim 16**, Renegar discloses a navigation apparatus for guiding users, comprising:

a map database for storing geographic information containing a place name text item representing each place name (navigating in areas; column 13, lines 52-67);

means for reading out the place name text item from the map database (streets, roads, destinations, landmarks, etc.; column 13, lines 52-67);

means for translating the place name text item in a first language into a new text item by replacing a first language character or string included in the place name text item and not included in a second language with a second language character or string in the second language having a pronunciation equivalent or similar to the pronunciation of the first language character or string in the first language (column 13, lines 52-67 with column 16, lines 40-67 and column 17, line 56 – column 18, line 35 with column 25, lines 6-30); and

means for generating voice by pronouncing the new text item according to the pronunciation of the second language (column 5, lines 64-67).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 7-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Renegar in view of Conkie (USPN 6,173,263).

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Regarding **claim 7**, Regenar teaches an automated voice generator for generating a voice output in the pronunciation of a second language corresponding to a text item in a different first language, comprising:

means for translating an original text item in a first language to be converted into voice into a new text item by replacing a first language character or string included in a full original text item and not included in a second language with a second language character or string in the second language having a pronunciation equivalent or similar to the pronunciation of the first language character or string in the first language (figure 2 with column 16, lines 40-67 and column 17, line 56 – column 18, line 35 with column 25, lines 6-30); and

means for generating voice by pronouncing the new text item according to the pronunciation of the second language (column 5, lines 64-67), but does not specifically teach translating abbreviated text.

Conkie discloses an apparatus wherein it translates abbreviated text (column 4, lines 31-57), in order to determine the syntactic structure of the sentence, so that it can be spoken with the proper intonation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Regenar's generator such that it comprises translating abbreviated text, as taught by Conkie, in order to distinguish sentence boundaries and to expand abbreviations into a pronounceable form (column 4, lines 31-31-57).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jakieda R. Jackson whose telephone number is 571-272-7619. The examiner can normally be reached on Monday, Tuesday and Thursday 7:30 a.m. to 5:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRJ
May 3, 2007



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